Remarks

The Official Action dated June 17, 2005 has been carefully considered. Consideration of the remarks presented herein and reconsideration of the rejections are respectfully requested.

Claims 1-8 and 10-24 remain in the present application

Rejections

Claims 1-24 were rejected in the Office Action under the argument that they are unpatentable over Strong (US Patent 6,167,523). In the Office Action, it was acknowledged that Strong does not disclose all elements of the claims and that Strong requires an entire form to be submitted before data is validated. However, it was argued in the Office Action that the differences between Strong and the claims would be a matter of programming choice because they are a matter of where and when to validate the data. Applicants respectfully traverse the rejections.

No Suggestion or Motivation to Modify Strong

A §103 rejection based upon a reference is not proper unless there is some suggestion or motivation to modify the reference, and the reference must teach or suggest all the claim limitations. MPEP § 2143. The teaching or suggestion to make the modification must be found in the prior art, not in applicants' disclosure. MPEP § 2143. In this case, the cited art provides no suggestion or motivation to modify the Strong system to arrive at the invention as claimed. For example, with reference to independent claim 1, there is no suggestion that input data should be validated on the server once received within the one field of the form, the validating occurring prior to the user providing data in other fields of the form. Rather, as explicitly stated in Strong at Column 7, lines 5-7, data is entered into the form and the form is

then submitted by using the submit button. Then, validation occurs on the <u>entire</u> submitted form. *See* Column 7, lines 33-35. Furthermore, no suggestion has been provided that input data should be received on the server <u>prior to</u> receiving input data for <u>other fields</u> of the form (e.g., such that that field data can validated once received before continuing with any other fields). Similarly, with respect to independent claim 8, there is no suggestion, for example, that input data should be validated <u>before</u> permitting the client to provide additional data associated with <u>the remainder</u> of the form. Rather, as mentioned, Strong appears to be directed toward the traditional method of submitting an entire form of data and then conducting the validation on that entire form. Likewise, with respect to the third independent claim, claim 17, no suggestion has been shown for modifying the reference such that the input data is received <u>prior to</u> the user inputting input data on the client for <u>any other portion</u> of the shipping form. Strong also does not suggest <u>interactively</u> validating on the server the received input data for the one portion of the shipping form <u>prior to</u> the user inputting input data on the client for <u>any other</u> portion of the shipping form and <u>without</u> requiring the user to activate a submit button. As mentioned above, Strong requires the user to submit the form first using a submit button.

Accordingly, Strong provides no suggestion that any deviation should be made from its process of submission of an entire form at once prior to validation, and the Office Action cites to no prior art to attempt to provide such a suggestion. Rather, without providing any citation or support, the Office Action alleges that such a change would be a matter of programming choice. Such an unsupported allegation cannot be used for the basis of obviousness, as it is the <u>prior art</u> that must provide the suggestion of the desirability of the claimed invention in order for an obviousness rejection to be proper. MPEP § 2143. "To imbue one of ordinary skill in the art with knowledge of the invention ... when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the

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insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W. L. Gore & Associates, Inc. v. Garlock Inc.*, 220 USPQ 303 at 312-13 (Fed. Cir. 1983).

Prior Art Does Not Teach the Problem or Its Source

In addition, the Strong reference does not acknowledge any problem in validating entire forms at one time. In contrast, the present inventors have not only acknowledged the problems with such a process, but have also provided solutions to those problems. When there is not evidence of record that a person of ordinary skill in the art at the time of an invention would have expected a problem, it is not proper to conclude that the invention that solves the problem would have been obvious to that hypothetical person of ordinary skill in the art. *See e.g., In re Peehs*, 612 F.2d 1287 (CCPA 1980).

Prior Art Teaching Away is an Important Indicium of Nonobviousness

Moreover, the Supreme Court has held that an important indicium of nonobviousness is "teaching away" from the claimed invention by the prior art. *See U.S. v. Adams*, 383 U.S. 39 (1966). In this case, the prior art Strong reference teaches validation after submission of an entire form which is opposed to a process that utilizes field by field or portion by portion validation. Accordingly, one would not be motivated to modify the Strong system to arrive at the present claims.

All Claim Elements Must be Considered Especially When Missing from the Prior Art

The Federal Circuit has continually cautioned against myopic focus on a difference between the prior art and the claimed invention rather than on the claimed invention as a whole relative to the prior art. *See, e.g., Hybritech Inc. v. Monoclonal Antibiotics*, 802 F.2d
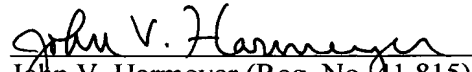
1367 (Fed. Cir. 1986). In this case, each of the claims as a whole recites the validation of one field or portion prior to the user providing other data for the form. This is as a whole entirely distinct from the Strong system which repeatedly requires the complete validation of an entire form after it is submitted in its entirety.

References are Not Properly Modifiable if Their Intended Function is Destroyed

The Strong reference is focused on use of a registry in a server that receives data from an electronic form submitted in full by a client. The data received from the form is evaluated to determine whether a registry key identifier is included in the data. In order to evaluate the data received from the form, information in one or more configuration registry keys under the registry key indicated by the identifier is accessed. *See e.g.,* Col. 3, lines 21-36. Such a registry key identifier is not required in the claims of the present application, and it is not clear how one could modify the Strong registry key system, which is focused upon processing of an entire form through use of registry keys and identifiers, to work with the present invention. The Federal Circuit has consistently held that when a § 103 rejection is based on a modification of a reference that destroys the intent, purpose, or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case of obviousness can not be properly made. *See In re Gordon,* 733 F.2d 900 (Fed. Cir. 1984).

Accordingly, it is respectfully requested that the rejections of the claims be withdrawn for at least these reasons. It is believed that the above represents a complete response to the rejections and that the present application is in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

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